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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,056

01/10/2006

Hiroyuki Okada

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03/23/2010

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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/23/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,056	<b>Applicant(s)</b> OKADA ET AL.	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5, 7, 1 to 14 and 16 to 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7, 1 to 14 and 16 to 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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1. Claims 1, 2, 4, 5, 7, 11 to 14 and 16 to 23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what weight is to be given to the phrase "adapted to be formed on a substrate". Specifically does the term "adapted" mean something in particular? While the "to be formed on a substrate" is a future intended use clause, it is unclear if "adapted" indicates some sort of modification (adaptation) or physical change to the claimed film. It is not clear how or if this language makes the coating film any different than a coating film that has not been "adapted to be formed on a substrate", i.e. a coating film as was previously claimed.

This confusion is particularly important because applicants argue that "coating" gives life and meaning to the claims. Thus a "coating film adapted..." must be clear and have a definite meaning.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 7, 11 to 14 and 16 to 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/083763 (as interpreted by Tamura et al.) in view of Fuchs, Ishikawa et al., Roberson or Lammerting for reasons of record.

The rationale for this rejection was detailed in previous office actions and as such will not be repeated.

Applicants place great emphasis on the fact that their claims are drawn to a coating film. As noted in the previous office action, such a film is not required to be attached to a substrate and can, in fact, be a free standing film. Since the Examiner cannot determine what weight to give the phrase "adapted to be formed on a substrate" this language does not lend any patentability to the claims. In fact, this language would

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appear to support the examiner's position since the film is adapted to be formed on a substrate (in other words a future intended use) and then it is then not actually on a substrate. Since the claims allow for a free standing film, the Examiner does not see a difference between the film (a thin lens) formed by the prior art and that claimed. Also note that claim 18 further limits the film of claim 1 to on a substrate. This also indicates that the film of claim 1 is not required to be on a substrate.

In addition, applicants place great emphasis on the desired effect of the modified silicone oil. While patentees suggest the addition of a silicone oil for a different reason than applicants, as noted previously, a prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. Thus the prior art need not suggest the addition of the silicone oil (C) to the composition of Tamura et al. for the same reason as applicants do. The resulting compositions, though, are the same.

Applicants are asked to note the rationale on the bottom of page 3 through page 4 of the office action dated 7/2/2009, as it further emphasizes this position.

4. Claims 1, 2, 4, 5, 7, 11 to 14 and 16 to 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohi in view of WO 02/083763 (as interpreted by Tamura et al.), further in view of Fuchs, Ishikawa et al., Roberson or Lammerting for reasons of record.

The rationale for this rejection was detailed in previous office actions and as such will not be repeated.

Applicants argue that a separate silanating agent is not required by the claims. This is not a persuasive argument, though, because the instant claims allow for such an agent. The fact that it is not required by the claims does not mean that it is excluded from the claims.

Applicants again try to import some type of breadth and meaning to the claims by relying on the phrase "coating film". However, as noted above, the film in claim 1 can be free standing. Applicants have not established or even provided specific arguments

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of how the free standing film of claim 1 distinguishes itself from the free standing lens in the prior art.

Contrary to applicants' assertion that the Examiner has not established a specific teaching of the specific modified silicone oils of the present claims, the Examiner disagrees. Each of the secondary (or tertiary) references teach a silicone oil within the breadth of (C).

Finally, any arguments of unexpected results are unsupported by fact.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
3/19/10